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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

MCA-652 US

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on December 1, 2005

Signature \_\_\_\_\_

Typed or printed name Stacey Gross

Application Number

10/823,171

Filed

April 13, 2004

First Named Inventor

Stephen P. Proulx

Art Unit

3754

Examiner

Joseph A. Kaufman

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

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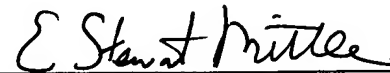
☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record. 50,316  
Registration number \_\_\_\_\_

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

E. Stewart Mittler

Typed or printed name

978-715-1086

Telephone number

December 1, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

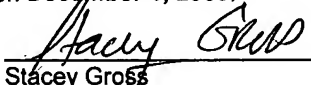
☒ \*Total of 1 forms are submitted.

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<b>Arguments in Support of Pre-Appeal Brief Request For Review</b>	Docket No. MCA 652 US
Applicant: Stephen P. Proulx Serial No: 10/823,171 Filed: April 13, 2004 For: Fluid Dispensing Apparatus Examiner: Joseph A. Kaufman Art Unit: 3754	

<p style="text-align: center;">CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a) The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on <b>December 1, 2005</b>.</p> <p style="text-align: right;"> Stacey Gross</p>
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**This paper is submitted in support of Applicant's request for a pre-appeal brief review:**

**Remarks/Arguments begin on page 2 of this paper.**

## **Remarks and Arguments**

Claims 1-12 are pending in this application. Claims 1-12 stand rejected under 35 U.S.C. § 103 as allegedly unpatentable in view of U.S. Patent No. 5,680,960 (hereinafter "Keyes") in view of U.S. Patent No. 3,607,100 (hereinafter, "Croom"). Applicant respectfully traverses the rejection.

### **35 U.S.C. § 103**

#### **1. The Prima Facie Case Requirement**

Applicant submits that the Office has not established a prima facie case of obviousness because: 1) the cited references do not teach all of the limitations set forth in the claims; and 2) a skilled artisan would not be motivated to combine the cited references as the Office suggests.

MPEP §2142. MPEP §2143 provides the standard required to establish a prima facie case of obviousness. "First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine what the reference teaches. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim limitations." The motivation to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The references must be considered as a whole and must suggest the desirability, and thus the obviousness of making the combination. *Hodosh v. Block Drug Co., Inc.*, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); MPEP § 2141.

#### **Claims 1-12**

The Office alleges that Keyes shows a reservoir, an inlet conduit, a first outlet conduit, a sight tube, a return conduit, a second outlet conduit, a first sensor, a second sensor, a first valve means and a second valve means. The Office admits that Keyes does not disclose the tapering of the interior sight tube and the number of first outlet conduits, but alleges that Croom shows a tapering conduit and further alleges that

providing additional outlet conduits would have been an obvious multiple use of an already employed structure. The Office concludes that it would have been obvious to the skilled artisan to provide a taper to the sight tube as taught by Croom in order to better control the flow out of the tube. The Office also suggests that it would have been obvious to provide additional outlet conduits.

### **The Cited References Do Not Teach All of the Claim Limitations**

The PTO has not met its burden in the instant case because the combined references do not teach or suggest all of the claim limitations. Specifically the Office points to 26 and 36 (Figure 1) in Keyes in support of its rejection, but ignores 23 and 22 in the same figure.

Claim 1 recites:

“A disposable tube set apparatus for delivering a precise volume of a fluid to containers which comprises:

- a reservoir for a fluid,
- an inlet conduit to said reservoir,
- at least one first outlet conduits from said reservoir,
- a sight tube connected to each of said at least one outlet conduit,

each of said sight outlet tubes having an interior wall tapered away from a central vertical axis of each of said sight outlet tubes,

- a return conduit connecting each of said sight outlet tubes to said reservoir,
- and a second outlet conduit connected to each of said sight tubes.”

Claims 2-12 depend on claim 1.

Applicant maintains that none of the cited references teach or suggest “a second outlet conduit connected to each of said sight tubes,” (emphasis added) as recited in the claim. Keyes discloses two distinct sight tubes represented in figure 1 as 23 and 36. Keyes states: “A pair of optical sensors 32 and 34 are disposed along the fill tube 36,” (column 5, lines 5-6); and “To maintain the fluid level in the fluid reservoir 12 at a predetermined level, a fluid level sensor 22 is positioned along side tube 23,” (Column 4, lines 37-39). Keyes continues: “The fluid level sensor 22 snaps around the outside of the side tube 23 and its vertical position determines the fluid level in fluid reservoir,”

(column 4, lines 45-47). The instant specification states: "By the term "sight tube," as used herein is meant a tube that is sufficiently transparent so a fluid level can be sensed at a lower portion of the sight tube by a first sensor positioned outside the sight tube and the top surface of a desired volume of the fluid can be sensed by a record sensor positioned outside the sight tube," (page 3, 1<sup>st</sup> paragraph). Applicant believes tube 23 is a sight tube and notes that tube 23 lacks a second outlet as required by the claim.

The Office has responded to Applicant's position by stating "only one sight tube is required as there is at least one outlet conduit." Applicant disagrees. At least one outlet conduit contemplates one or more outlet conduits, where each one has a sight tube connected, and a second outlet connected to each sight tube. While a plurality of outlet conduits and sight tubes are contemplated the claim states that when a plurality of sight tubes are present the sight tubes must also have a second outlet conduit connected to each of said sight tubes (as well as the other elements recited in the claim, e.g., an inlet, at least a first outlet; a second outlet). Keyes does not teach or suggest all of these elements of the claim (see tube 23 in Figures 1, and 3-8). Neither does Croom. Accordingly, claims 1-12 are not prima facie obvious in view of Keyes combined with Croom. Applicant respectfully requests withdrawal of the rejection.

#### **No Motivation to Combine Keyes With Croom**

Applicant previously submitted arguments explaining why a skilled artisan would not be motivated to combine Keyes with Croom (see "Response" mailed July 13, 2005, pp. 6-7). Applicant hereby incorporates those arguments into this response. Moreover, in responding to Applicant's previously submitted comments the Office appears to admit that no explicit motivation existed to suggest combining Keyes with Croom.

Nonetheless, the Office maintains that implicit motivation is useable. Applicant notes that the Office provides no authority for this position. Accordingly, Applicant respectfully calls upon the Office to cite some authority to support its position. Moreover, the Office is urged to consider *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991), which states that the motivation to combine must be found in the references themselves.

Applicant notes that MPEP §2144.02 (entitled "Implicit Disclosure") states that "in considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference, but also the inferences one skilled in the art would

reasonably be expected to draw therefrom," (emphasis added). However, no mention is made regarding motivation. Indeed, the two cases cited in §2144.02 (*In re Prada* 159 USPQ 342, 344 (CCPA 1968); *In re Lamberti* 192 USPQ 278, 280 (CCPA 1976)) both concern the "all elements requirement," not motivation.

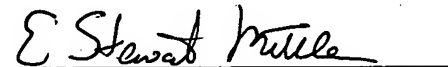
Applicant believes no motivation to combine Keyes with Croon existed for the reasons stated previously in response to the Office Action dated June 23, 2005. Accordingly, Applicant respectfully requests withdrawal of the rejection.

### **CONCLUSION**

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account.

Respectfully submitted



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